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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,111	08/30/2001	William B. Kerfoot	10578-002005	9810

26161 7590 09/16/2003

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EXAMINER

HOEY, BETSEY MORRISON

ART UNIT PAPER NUMBER

1724

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

**Office Action Summary**

Application No.

09/943,111

Applicant(s)

KERFOOT, WILLIAM B.

Examiner

HOEY, BETSEY

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1724

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 9-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 10 and 11, respectively, of U.S. Patent No. 6,284,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only additional limitations in the instant claims are limitations that are inherent to the method as claimed in the patented claims. The instant claims recite that when microbubbles containing ambient air and ozone are introduced into the soil, contaminants in a dissolved state in the soil formation are pulled through the microbubbles where they react with ozone in the microbubbles according to Henry's law. Although the patented claims do not recite this much detail, one of ordinary skill in the art would expect this reaction to naturally occur when practicing the method of the patented claims, and is therefore considered an inherent aspect of the method.

3. Claims 16-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-23, respectively, of U.S.

Patent No. 6,284,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only additional limitations in the instant claims are limitations that are inherent to the method as claimed in the patented claims. The instant claims recite that when microbubbles containing ambient air and ozone are introduced into moist soils, contaminants in a dissolved state in the soil formation are pulled through membranes of the microbubbles where they react with ozone in the microbubbles. As explained above, although the patented claims do not recite this much detail, one of ordinary skill in the art would expect this reaction to naturally occur when practicing the method of the patented claims, and is therefore considered an inherent aspect of the method.

4. Claims 26-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,284,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only additional limitations in the instant claims are limitations that are inherent to the method as claimed in the patented claims. The instant claims recite that specifically sized bubbles of oxidizing gas are injected into a site, which promotes pulling of contaminants into the bubbles to decompose contaminants in a reaction with the gas. The patented claims recite that the same sized bubbles (see claim 5) of a specific type of oxidizing gas, which reads on the instant claims, are introduced to a site, and one of ordinary skill in the art would expect the reaction recited in the instant claims to naturally occur when practicing the method of

Art Unit: 1724

the patented claims. Therefore, the limitations of the instant claims are considered an inherent aspect of the method of the patented claims.


5. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

6. Applicant indicates that a terminal disclaimer will be filed when indication of allowable subject matter is received. However, the instant claims cannot be considered allowable so long as they are rejected under double patenting.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betsey Hoey whose telephone number is (703) 305-3934. The fax phone number for official after final faxes for this Group is 703-872-9311 for all other official faxes the number is 703-872-9310, and for unofficial faxes the number is (703) 305-7115. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
**BETSEY MORRISON HOEY**  
**PRIMARY EXAMINER**

September 13, 2003